UNITED STATES PATENT AND TRADEMARK OFFICE

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 April 2005*.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *46-65* is/are pending in the application.
　　4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) *46-65* is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
　　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
　　Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
　　a)☐ All   b)☐ Some * c)☐ None of:
　　　1.☐ Certified copies of the priority documents have been received.
　　　2.☐ Certified copies of the priority documents have been received in Application No. _____.
　　　3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
　* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
　　Paper No(s)/Mail Date *7/26/2006*.
4) ☐ Interview Summary (PTO-413)
　　Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____ .

DETAILED ACTION

1.   This communication is responsive to the application filed on April 14, 2005.

Claims 46-65 are pending and presented for prosecution.

References in applicant's IDS form 1449 have been considered.

Claim Rejections - 35 USC § 112

2.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of
> making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the
> art to which it pertains, or with which it is most nearly connected, to make and use the same and shall
> set forth the best mode contemplated by the inventor of carrying out his invention.

3.   Claim 53 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply

with the written description requirement. The claim(s) contains subject matter which

was not described in the specification in such a way as to reasonably convey to one

skilled in the relevant art that the inventor(s), at the time the application was filed, had

possession of the claimed invention. Applicant recites limitations "affecting the-

telephone behavior according to the data read from the SIM or card" is not found in the

specification.

Claim Rejections - 35 USC § 102

4.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5.   Claim 46 is rejected under 35 U.S.C. 102(b) as being anticipated by Horne et al.

("Horne") (US Patent #6,247,644).

Regarding claim 46, Horne teaches a device comprising: a smart card reader

(Figures 1 and 2, smart card reader 12) configured to communicate with a smart card

(Col 4, lines 14-46; figure 2, smart card reader 12 configured to communicate with a

smart card) and at least one network interface, wherein the at least one network

interface is adapted for communication with any of a LAN, a Wireless LAN, a landline

telephone, a cellular telephone, a peripheral-wire communications port, a wireless

communications infra-red (IR) port, and an audio tones interrogator (Col 4, lines 14-46;

Col 3, line 30-44).

6.   Claims 47 and 48 are rejected under 35 U.S.C. 102(e) as being anticipated by

Haverinen et al. (US Patent #7,107,620).

Regarding claim 47, Haverinen teaches a device comprising: a Secure

Information Module (SIM) (Col 18, lines 45-lines 56); and at least one network interface,
wherein the at least one network interface is adapted for communication with any of a
LAN, a Wireless LAN, a landline telephone, a cellular telephone, a peripheral-wire
communications port, a wireless communications infra-red (IR) port, and an audio tones
interrogator (Col 18, lines 45-lines 56).

Regarding claim 48, Haverinen teaches a smart card comprising a network
interface adapted for communication with any of a LAN, a Wireless LAN, a landline
telephone, a cellular telephone, a peripheral-wire communications port, a wireless
communications infra-red (IR) port, and an audio tones interrogator (Col 18, lines 45-
lines 56).

7.   Claims 53,54,57-60 are rejected under 35 U.S.C. 102(e) as being anticipated by
Ahuja et al. (US Pub. No. #2001/0056402).

Regarding claim 53, Ahuja teaches a method for personalizing a telephone
connectable to a PSTN (Paragraph 0067), the method comprising the steps of:
connecting a device to a PSTN telephone line or to a telephone (Paragraph 0067), the
device comprising a SIM (Secure Information Module) or a smart card reader configured
to communicate with the PSTN (Paragraph 0067); reading data stored on the SIM or on
a smart card (Paragraph 0051); and affecting the-telephone behavior according to the
data read from the SIM or card *(Paragraphs 0053-0057: Ahuja teaches a first wireless
terminal 100, in Figure 6A, for use with a smart card. This terminal 100 includes a*

customer interface 102, such as an alpha-numerical keypad 104, a display 106, and a

smart card reader 108. Signals provided from a wireless service provider, such as one

described in FIG. 1, are received by a transmitter/receiver portion 110 of the terminal

100. Conversely, signals are provided from the transmitter/receiver portion 110 of the

terminal 100 to a front end processor via wireless service provider. In this manner, the

terminal 100 may be used to wirelessly receive and transmit data to and from a financial

institution or financial network. This data may then be read and write from and onto a

smart card that is inserted into the smart card reader 108, so inserting and reading from

the SIM card affecting the telephone behavior).

Regarding claim 54, Ahuja teaches the method, further comprising the step of

storing data on said SIM or said smart card (Paragraph 0053).

Regarding claim 57, Ahuja teaches the method, further comprising the step of

identifying the SIM or smart card owner (Paragraph 0078).

Regarding claim 58, Ahuja teaches a method for receiving any of SMS

messages (text message), MMS messages, and e-mail messages via a network

interface (Paragraph 0082), the network interface comprising either of a PSTN and a

LAN or a Wireless LAN (Paragraph 0067), the method comprising the steps of:

connecting a device to the network interface (Paragraph 0067), said device comprising

a controller (Paragraph 0089) in communication with an internal SIM (Secure

Information Module) or a smart card reader (Paragraph 0067); reading identification

data (ID) from the SIM or a smart card (Paragraphs 0052-0055, especially paragraph

0055); and performing a handshake with any of an SMS server, an MMS server, and an

e-mail server via the network interface *(Paragraphs 0052-0056, especially paragraph 0052, Using encryption techniques, it is possible not only to encode financial information stored remotely by a host computer or locally on the smart card, but also to encode identification information, such as personal identification numbers (PINs).*

The user may insert a smart card into the smart card reader 108. The card first encrypts, then transmits to the terminal 100 information stored on a smart card. This information identifies the financial institution which maintains the user's account as well as the user's account number. Additional security may be obtained by requiring that the user input a PIN with the numeric keypad. Again, the smart card can then encrypt the PIN for transmission by the terminal to a host computer for verification. Once authorization has been obtained, the user may determine the user's current account balance and/or request that value be added to the card. In executing these requests, the terminal exchanges encoded information by wireless transmission with a financial network same as performing handshake with network server).

Regarding claim 59, Ahuja teaches the method, wherein the step of performing a handshake comprises the steps of: i. transmitting the ID to said server *(Paragraph 0055-0056: Ahuja teaches the user may insert a smart card into the smart reader 108. The card first encrypts, then transmits to the terminal 100 information stored on a smart card. This information identifies the financial institution which maintains the user's account as well as the user's account number. Additional security may be obtained by requiring that the user input a PIN with the numeric keypad. Again, the smart card can then encrypt the PIN for transmission by the terminal to a host computer for verification.*

Once authorization has been obtained, the user may determine the user's current

account balance and/or request that value be added to the card. In executing these

requests, the terminal exchanges encoded information by wireless transmission with a

financial network, so transmitting the ID to network server); and ii. said server

downloading said messages respectively associated with the ID of the SIM or card

(Paragraphs 0055-0056, *security may be obtained by requiring that the user input a PIN*

with the numeric keypad. Again, the smart card can then encrypt the PIN for

transmission by the terminal to a host computer for verification. Once authorization has

been obtained, the user may determine the user's current account balance and/or

request that value be added to the card. In executing these requests, the terminal

exchanges encoded information by wireless transmission with a financial network, so

the network server downloading messages respectively associated with the ID or PIN of

the SIM or card).

      Regarding claim 60, Ahuja teaches a method for automatically rerouting data

services to current location, the method comprising the steps of: sending identification

information stored on a SIM or a smart card to a service provider*(Paragraphs 0052-*

0056, especially paragraph 0052, Using encryption techniques, it is possible not only to

encode financial information stored remotely by a host computer or locally on the smart

card, but also to encode identification information, such as personal identification

numbers (PINs). The user may insert a smart card into the smart card reader 108. The

card first encrypts, then transmits to the terminal 100 information stored on a smart

card. This information identifies the financial institution which maintains the user's

account as well as the user's account number. Additional security may be obtained by requiring that the user input a PIN with the numeric keypad. Again, the smart card can then encrypt the PIN for transmission by the terminal to a host computer for verification. Once authorization has been obtained, the user may determine the user's current account balance and/or request that value be added to the card. In executing these requests, the terminal exchanges encoded information by wireless transmission with a financial network same as performing handshake with network server); and accepting the data messages and telephone calls (para. 077-0078) associated with the identification information (Para. 0086-0090) at the current location *(Paragraph 0054, the terminal 100 may be advantageously used to read data stored on a smart card to determine a value corresponding to an amount of funds existing in the user's account. Para. 0055, the user may insert a smart card into the smart card reader 108. The card first encrypts, then transmits to the terminal 100 information stored on a smart card. Additional security may be obtained by requiring that the user input a PIN with the numeric keypad. The smart card can then encrypt the PIN for transmission by the terminal to a host computer for verification. Para. 0056, once authorization has been obtained, the user may determine the user's current account balance and the terminal exchanges encoded information by wireless transmission with a financial network)*, wherein the data services comprises any of telephone calls, SMS messages, MMS messages, and e-mail messages (Para. 0082), and wherein the current location comprises one of a group including a landline telephone connectable to any of a PSTN,

a cellular telephone (Para. 0050), and a LAN or Wireless LAN access point (para.

0045).

Claim Rejections - 35 USC § 103

8.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9.   Claim 49 is rejected under 35 U.S.C. 103(a) as being unpatentable over Horne et

al. ("Horne") (US Patent #6,247,644) in view of Keys et al. (US Patent #6,758,403).

Regarding claim 49, Horne fails to teach the device wherein the smart card is

configured to do at least one of the following: store identification (ID) data associated

with the smart card and store messages sent and received from any of an SMS server,

an MMS server, and an e-mail server; and support editing of any of SMS messages,

MMS messages, and e-mail messages.

However, in related art, Keys teaches the device wherein the smart card is

configured to do at least one of the following: store identification (ID) data associated

with the smart card and store messages sent and received from any of an SMS server,

an MMS server, and an e-mail server; and support editing of any of SMS messages,

MMS messages, and e-mail messages (Col 1, lines 38-43).

Therefore, it would have been obvious to one of ordinary skill in the art at the

time of the invention to provide the above teaching of Keys to Horne so that message

data can be generated in a custom format customized to best suited to the needs of a

user (Keys, Col 1, lines 32-35).

10.   Claim 50 is rejected under 35 U.S.C. 103(a) as being unpatentable over Horne et

al. ("Horne") (US Patent #6,247,644) in view of Ahuja et al. (US Pub. No.

2001/0056402).

     Regarding claim 50, Horne fails to teach the device configured to be

connectable either between any of said telephones and the wall socket of a telephone

line or between a telephone base and a telephone handset.

     However, Ahuja teaches the device configured to be connectable either between

any of said telephones and the wall socket of a telephone line or between a telephone

base and a telephone handset (Paragraph 0067).

     Therefore, it would have been obvious to one of ordinary skill in the art at the

time of the invention to provide the above teaching of Ahuja to Horne in order to

successfully accomplish the financial transactions (See Abstract).

11.   Claim 51 is rejected under 35 U.S.C. 103(a) as being unpatentable over Horne et

al. ("Horne") (US Patent #6,247,644) in view of Katz et al. (US Pub. No. 2006/0291455).

     Regarding claim 51, Horne fails to teach the device, configured to be integrated

into said cellular telephone or a cellular telephone battery.

However, in related art, Katz teaches the device, configured to be integrated into

said cellular telephone or a cellular telephone battery (Paragraph 0245).

Therefore, it would have been obvious to one of ordinary skill in the art at the

time of the invention to provide the above teaching of Katz to Horne in order to

wirelessly transmit transaction data to the billing company.

12.   Claim 52 is rejected under 35 U.S.C. 103(a) as being unpatentable over Horne et

al. ("Horne") (US Patent #6,247,644) in view of Weiss et al. (US Patent #5,821,983).

Regarding claim 52, Horne fails to teach the device wherein the device is

integrated into any of said telephones or into a telephone handset.

However, in related art, Weiss teaches the device wherein the device is

integrated into any of said telephones or into a telephone handset (Col 1, lines 44-55).

Therefore, it would have been obvious to one of ordinary skill in the art at the

time of the invention to provide the above teaching of Weiss to Horne in order to

transmit transaction data to the billing company through the wired telephone line.

13.   Claims 55 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Ahuja et al. (US Pub. No. 2001/0056402) in view of Tarkiainen et al. (US Pub. No.

2001/0041560).

Regarding claim 55, Ahuja fails to teach the method, further comprising the

steps of: selecting an action from a list of actions stored on either the SIM or the card; and activating the telephone to perform the selected action.

However, in related art, Tarkiainen teaches the method, further comprising the steps of: selecting an action from a list of actions stored on either the SIM or the card; and activating the telephone to perform the selected action (Paragraph 0043).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the above teaching of Tarkiainen to Ahuja in order to communicate with other devices.

Regarding claim 56, the combination of Ahuja and Tarkiainen teaches all the claimed limitations in claim 55. In addition, Tarkiainen teaches the method, wherein the step of activating comprises at least one of a list of actions including: dialing a telephone number, sending any of an SMS message, an MMS message, and an e-mail message via a service provider or dedicated server, changing to a new list, adding and editing telephone numbers, allocating "quick dial" numbers and accessing a call register of received, dialed and missed calls; and further comprising storing the result of the step of performing on the SIM or the card (Paragraph 0043).

14.   Claim 61 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ahuja et al. (US Pub. No. 2001/0056402) in view of Hutchison,IV et al. (US Pub. No. 2001/0034246).

Regarding claim 61, Ahuja fails to teach a method comprising: personalizing a telephone by performing at least one of the following steps: reading telephone personalization data stored on smart card, and storing telephone personalization data on the smart card.

However, in related art, Hutchison, IV teaches a method comprising: personalizing a telephone by performing at least one of the following steps: reading telephone personalization data stored on smart card, and storing telephone personalization data on the smart card (Paragraphs 0005 and 0040).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the above teaching of Hutchison, IV to Ahuja in order to make a call to other terminal.

15.   Claims 62 and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haverinen et al. (US Patent #7,107,620) in view of Keys et al. (US Patent #6,758,403).

Regarding claim 62, Haverinen fails to teach the device further comprising a smart card configured to perform at least one of the following steps: store identification (ID) data associated with the smart card and to store messages sent and received from any of an SMS server, an MMS server, and an e-mail server, and support editing of any of SMS messages, MMS messages, and e-mail messages.

However, in related art, Keys teaches the device further comprising a smart card configured to perform at least one of the following steps: store identification (ID) data associated with the smart card and to store messages sent and received from any of an SMS server, an MMS server, and an e-mail server, and support editing of any of SMS messages, MMS messages, and e-mail messages (Col 1, lines 38-43).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the above teaching of Keys to Horne so that message data can be generated in a custom format customized to best suited to the needs of a user (Keys, Col 1, lines 32-35).

Regarding claim 63, Haverinen fails to teach the device wherein the smart card is configured to perform at least one of the following steps: store identification (ID) data associated with the smart card and to store messages sent and received from any of an SMS server, an MMS server, and an e-mail server, and support editing of any of SMS messages, MMS messages, and e-mail messages.

However, in related art, Keys teaches the device further comprising a smart card configured to perform at least one of the following steps: store identification (ID) data associated with the smart card and to store messages sent and received from any of an SMS server, an MMS server, and an e-mail server, and support editing of any of SMS messages, MMS messages, and e-mail messages (Col 1, lines 38-43).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the above teaching of Keys to Haverinen so that message data can be generated in a custom format customized to best suited to the

needs of a user (Keys, Col 1, lines 32-35).

16.   Claim 64 is rejected under 35 U.S.C. 103(a) as being unpatentable over

Haverinen et al. (US Patent #7,107,620) in view of Ahuja et al. (US Pub. No.

2001/0056402).

        Regarding claim 64, Haverinen fails to teach the device configured to be

connectable either between a telephone and the wall socket of a telephone line or

between a telephone base and a telephone handset.

        However, Ahuja teaches the device configured to be connectable either between

a telephone and the wall socket of a telephone line or between a telephone base and a

telephone handset (Paragraph 0067).

        Therefore, it would have been obvious to one of ordinary skill in the art at the

time of the invention to provide the above teaching of Ahuja to Haverinen in order to

successfully accomplish the financial transactions (See Abstract).

17.   Claim 65 is rejected under 35 U.S.C. 103(a) as being unpatentable over

Haverinen et al. (US Patent #7,107,620) in view of Weiss et al. (US Patent #5,821,983).

        Regarding claim 65, Haverinen fail to teach the device wherein the device is

integrated into any of said telephones or into a telephone handset.

However, in related art, Weiss teaches the device wherein the device is integrated into any of said telephones or into a telephone handset (Col 1, lines 44-55).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the above teaching of Weiss to Haverinen in order to transmit transaction data to the billing company through the wired telephone line.

18.   Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in its entirety as potentially teaching of all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Conclusion

19.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Titmuss et al. (US Patent #6,167,122), Farrugia et al. (US Pub. No. 2002/0100798), Prise (US Pub. No. 2007/0015539), Shaw, JR. et al. (US Pub. No. 2004/0007617), Perron et al. (US Pub. No. 2002/0047049), Tano et al. (US Patent #7,079,927), Bahl et al. (US Pub. No. 2006/0019724), Vasnier et al. (US Patent #6,504,932), Boyer et al. (US Patent #6,745,047).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DOMINIC E. REGO whose telephone number is (571)272-8132. The examiner can normally be reached on Monday-Friday, 8:30 am-5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew D. Anderson can be reached on 571-272-4177. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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